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EXAMINER	
REIS, TRAVIS M	

ART UNIT	PAPER NUMBER
2859	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Acti n Summary	Application No. 09/973,955	Applicant(s) MURRAY, JOHN C.	
	Examiner Travis M Reis	Art Unit 2859	

-- The MAILING DATE of this communicati n appears on the c ver sh et with th correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 January 2003* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-21* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *11 October 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *9* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the film of plastic material having measuring indicia formed thereon disclosed in claim 13 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the plurality of layers of plastic material disclosed in claim 14 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the reinforcing member disclosed in claim 15 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the fiber disclosed in claim 16 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Objections

5. Claims 10-12 are objected to because of the following informalities:

Claim 10 recites the limitation "said hook member mounting portion" in lines 2-3 & "said hook portion" in lines4-5. There is insufficient antecedent basis for this limitation in the claim.

Claims 11 & 12 are objected to due to their dependence upon Claim 10.

6. Claims 15 & 16 are objected to because of the following informalities:

Claim 15 recites the limitation "at least one reinforcing member" in line 2. There is insufficient antecedent basis for this limitation in the claim in the specification.

Claim 16 recites the limitation "a fiber" in line 2. There is insufficient antecedent basis for this limitation in the claim in the specification.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 1, 13, 14, & 17-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al. (U.S. Patent 4527334) in view of Bayerische (DE 3621368A1) & Choi (U.S. Patent 5544420).

With reference to claims 1, 13, 17, & 18, Jones et al. discloses a retractable rule assembly (10) comprising a housing assembly (11); a reel (26) rotatably mounted in said housing assembly; an elongated blade (17) formed of a ribbon of metal having one end connected to said reel, said blade extendable from a position tangential to said reel outwardly through a spaced opening in said housing assembly, said elongated blade having measuring indicia (Figure 4) formed on the upper side thereof, and a clear, plastic, protective coating

(col. 2 lines 63-64) provided on both sides of said blade throughout the length of the blade for inhibiting wear of said measuring indicia; a coil spring (31) formed of a ribbon of metal constructed to rotate said reel in said housing assembly in a direction to wind up the elongated blade when extending outwardly of said housing assembly onto said reel in an abutting volute coil formation in a flattened cross-sectional configuration (col. 3 lines14-15), and a blade holding assembly (23) constructed to hold the blade in any position of extension outwardly of said housing assembly opening and to release the blade from any position in which it is held.

Jones et al. do not disclose a relatively short free end portion of said blade having a film of plastic material overlying a protective coating on at least one of the convex and concave sides of the blade, the film of plastic material extending across 100% of the blade width, with the film of plastic material having measuring indicia formed thereon.

Bayerische discloses a measuring tape (4) with a thick film of plastic material (9) (Figure 6) provided on both sides overlying a blade and said film extending across 100% of the blade width of the measuring tape having to prevent kinking of the end of the blade (Figure 3) said film also having measuring indicia formed thereon (col. 4 lines 31-32). Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention was made to add the film of plastic material disclosed by Bayerische to the blade disclosed by Jones et al. in order to prevent kinking of the end of the blade & to see measuring indicia.

Jones et al. & Bayerische do not disclose the film of plastic material having a thickness greater than a thickness of the protective coating. However, to choose a film of plastic material thicker than the plastic coating, absent any criticality, is only considered to be an " optimum " value of the film of plastic material and the protective coating, as stated above, that

a person having ordinary skill in the art would have been able to determine using routine experimentation based, among other things, on the desired accuracy and since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. See ***In re Boesch***, 205 USPQ 215 (CCPA 1980).

Jones et al. & Bayerische do not disclose said elongated blade housing a concave-convex configuration when extended from said housing assembly.

Choi discloses a combination tape measure and light bulb with a measuring blade (12) in a concavo-convex configuration when extended from said housing assembly (Figure 5). Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention was made to form the blade disclosed by Jones et al. in the manner taught by Choi in order that the blade will remain straight and be urged to not droop when extended.

With reference to claim 14, Jones et al, Bayerische, & Choi do not disclose that said film of plastic material comprises a plurality of layers of plastic material. However, Official notice is taken with respect to the plurality of layers of plastic material since it is very well known in the art to use a plurality of layers of plastic material to increase the strength & durability of the plastic material. Thus, to include a plurality of layers of plastic material disclosed by Jones et al, Bayerische, & Choi would have been obvious to a person having ordinary skill in the art at the time the invention was made since the plastic material will be greater subject to wear with merely one layer of material.

With reference to claim 19, Although Jones et al. do not disclose the protective coating comprises a plastic material having a thickness dimension less than about .0035", it is inherent that the protective coating has a thickness, To choose a thickness of 0.0035" or less for the protective coating disclosed by Jones et al., absent any criticality, is only considered to be the " optimum " value of the thickness of the coating disclosed by Jones et al., as stated

above, that a person having ordinary skill in the art would have been able to determine using routine experimentation based, among other things, on the desired manufacturing costs and since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. See ***In re Boesch***, 205 USPQ 215 (CCPA 1980).

With reference to claim 20, Jones et al., Bayerische, & Choi disclose a layer of painted indicia between said blade and said protective coating (col. 2 line 64).

Jones et al., Bayerische, & Choi do not disclose said layer of paint having a thickness of between .0006"-.0014". However, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide a layer of paint having a thickness in the range of .0006"-.0014", since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the "optimum range" involves only routine skill in the art. ***In re Aller***, 105 USPQ 233.

With reference to claim 21, Jones et al., Bayerische, & Choi do not disclose that said protective coating is formed from a material selected from the group consisting of polyamides, polyvinyl, polyesters, silicone, polyimides, polyethylene, fluoropolymers and polyethylene terephthalate. However, the particular type of material used to make the protective coating, absent any criticality, is only considered to be the use of a " preferred " or " optimum " material out of a plurality of well known protective coating materials that a person having ordinary skill in the art at the time the invention was made would have find obvious to provide using routine experimentation based, among other things, on manufacturing costs the intended use of Applicant's apparatus, i.e., suitability for the intended use of Applicant's apparatus, and since the courts have stated that a selection of a material on the basis of suitability for intended use of an apparatus would be entirely obvious. See In re Leshin, 125 USPQ 416 (CCPA 1960).

9. Claims 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al., Bayerische, & Choi as applied to claims 1, 13, & 17-21 above, and further in view of Kobayashi (JP

With reference to claims 2, Jones et al., Bayerische, & Choi disclose all of the instant claimed invention as stated above in the rejection of claims 1, 13, & 17-21 but do not disclose that said plastic film is comprised of a material selected from a group consisting of polyurethane, Mylar and Nylon.

Kobayashi discloses a steel tape measure with a transparent nylon covering (Constitution line 7). Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention was made to make the film of plastic material taught by Jones et al., Bayerische, & Choi out of Nylon as taught by Kobayashi since the use of the particular type of plastic by Applicant is considered to be nothing more than the use of one of numerous and well known alternate types of plastics that a person having ordinary skill in the art would have been able to provide using routine experimentation in order to prevent the kinking of the end of the tape as already suggested by Jones et al., Bayerische, & Choi.

10. Claims 3-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al., Bayerische, Choi, & Kobayashi as applied to claim 2 above, and further in view of Bradshaw et al. (U.S. Patent 4900392).

With reference to claim 3, Jones et al., Bayerische, Choi, & Kobayashi disclose all of the instant claimed invention as stated above but do not disclose expressly said film selected from said group is secured to said plastic coating with an acrylic adhesive.

Bradshaw et al. discloses a slidable indicia alignment and transfer device that uses an acrylic adhesive which is common to the art of securement (col. 4 lines 27-39). Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention was

made to use the acrylic adhesive taught by Bradshaw et al. to secure the film to the coating taught by Jones et al., & Bayerische in order to keep the film secured to the coating and thus the blade during use.

With reference to claim 4, Jones et al., Bayerische, Choi, Kobayashi, & Bradshaw disclose said film extends from the free end of the blade to approximately the point where the blade is in said abutting volute configuration when said blade is fully retracted (Bayerische Figure 3).

With reference to claim 5, Jones et al., Bayerische, Choi, Kobayashi & Bradshaw disclose all of the instant claimed invention as stated above, but do not disclose expressly that the length of the portion of the blade covered by said film is approximately 12 inches or less. However, to choose a length of 12" or less for the length of the film, absent any criticality, is only considered to be the " optimum " value of the length of the film, as stated above, that a person having ordinary skill in the art would have been able to determine using routine experimentation based, among other things, on the desired accuracy and since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. See ***In re Boesch***, 205 USPQ 215 (CCPA 1980).

With reference to claims 6 & 8, Jones et al., Bayerische, Choi, Kobayashi, and Bradshaw disclose all of the instant claimed invention as stated above but do not disclose expressly that said film has a thickness dimension within a range of 0.006" to 0.014". However, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide the film having a thickness of between .0006" - .0014", since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the "optimum range" involves only routine skill in the art. ***In re Aller***, 105 USPQ 233.

With reference to claims 7 & 9, Jones et al., Bayerische, Choi, Kobayashi, & Bradshaw, disclose said retractable rule further comprises an end hook member formed of sheet metal of a predetermined thickness to include a concavo-convex mounting portion (21) and a U-shaped hook portion (20) that is bent at a generally right angle from an end (19) of said mounting portion, and said end hook member being mounted on the free end of said blade with the mounting portion of said hook member being secured for limited movement with respect to the free end of the blade so that said rule can be measured externally from an exterior surface of said U-shaped hook portion or internally from an interior surface of said U-shaped hook portion (Jones Figures 1 & 2).

With reference to claims 10-12, Jones et al., Bayerische, Choi, Kobayashi, and Bradshaw disclose all of the instant claimed invention as stated above including said housing opening has a height dimension which exceeds the height dimension of a hook member mounting portion and its connection with the free end of said blade an amount which is at least approximately equal to the amount a hook portion (20) extends below said bottom end surface of said housing assembly when at said housing opening (Jones Figure 4); and the lateral edges of said mounting portion adjacent said hook portion provide upwardly facing surfaces (18) which engage one or more downwardly facing surfaces (Jones Figure 4) defining the housing opening to limit the upward movement of said hook member within said opening (Jones Figure 3).

11. Claims 15 & 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al., Bayerische, & Choi as applied to claims 1, 2 & 13, 17-21 above, and further in view of Beeber (U.S. Patent 2994958).

Jones et al., Bayerische, & Choi do not disclose the film of plastic material comprises at least one fiber reinforcing member.

Beeber discloses measuring tape with a film of plastic material (8) with filament reinforcing members (10) which can be made of fibers such as polyester (col. 2 lines 53-56) (Figure 2). Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention was made to add the filament reinforcing members disclosed by Beeber to the film of plastic material in order to increase the strength of the film during use.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Travis M Reis whose telephone number is (703) 305-4771. The examiner can normally be reached on 8:00--5:00 Monday--Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego Gutierrez can be reached on (703) 308-3875. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-8160 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Travis M Reis
Examiner
Art Unit 2859
tmr
March 5, 2003

Diego Gutierrez
Supervisory Patent Examiner
Technology Center 2800